

REMARKS

The Specification and claims 24 and 26, have been amended. The allowance of claims 29-31, and the allowability of claims 24-28, are hereby noted with appreciation. A substitute application data sheet is included herewith. Re-examination and reconsideration of the application, in view of the amendments above and remarks below, are respectfully requested.

The specification has been amended to reflect that the instant application is a divisional of U.S. Serial No. 09/153,626 filed September 15, 1998, now U.S. Patent No. 6,243,931 issued June 12, 2001. In addition, and as requested in the Response To Request For Corrected Filing Receipt dated February 12, 2003, a substitute application data sheet also indicating that the present application is a divisional of U.S. Serial No. 09/153,626 filed September 15, 1998, now U.S. Patent No. 6,243,931 issued June 12, 2001 is enclosed.

The Examiner rejected claims 21-23 and 35 under 35 U.S.C. §103(a) as being unpatentable over Edwards U.S. Patent No. 1,507,957, Elder U.S. Patent No. 4,730,370 and Nishibori U.S. Patent No. 4,610,900. Reconsideration and withdrawal of the rejection is respectfully requested.

Of the claims rejected, claims 21 and 35 are independent claims. Both of these independent claims are directed to a casket lid, not the lower body or shell portion of the casket as is disclosed in Edwards. Elder, cited for showing a casket lid, does not in any way relate to a lid manufactured from settable material. Lastly,

Nishibori is completely unrelated to caskets at all; far from being related to caskets, Nishibori is related to cellulose aggregate containing synthetic resin products molded into sheets, rods, boxes and the like to be used as a material for buildings such as floors, walls and ceilings, for furniture such as desks and cabinets and for the interior of automobiles. See Nishibori at Column 3, lines 58-62. Thus, assuming without admitting that the combination of the three references is even proper, which combination Applicants maintain is improper, the combination does not even yield the invention claimed in the claims under rejection.

Claim 21 calls for a casket lid. The casket lid comprises a crown, a pie at one end of the crown, the crown and pie together comprising a cover having a pair of sides and a pair of ends, a header at one end of the ends of the cover opposite from the pie and a side rim member at each of the pair of cover sides and an end rim member at the other of the cover ends, wherein the crown, pie, rim members and header are molded as a one-piece, unitary structure. Claim 35 is also for a casket lid. The claim calls for a crown, a pie at one end of the crown, the crown and pie together comprising a cover having a pair of sides and a pair of ends, and a side rim member at each of the pair of cover sides and an end rim member at the other of the cover ends, wherein the crown, pie and rim members are molded as a one-piece, unitary structure.

It is submitted that the Examiner has simply used Applicant's claims as a blueprint to abstract bits and pieces of prior art together, through hindsight, to make

the above §103 rejections. It must be recognized that a combination of prior art is improper and not "obvious" if the only suggestion or reason for combining the teachings of the prior art is to be found in the present application. In re Pye & Peterson, 148 USPQ 426 (CCPA 1966). Furthermore, it must be recognized that the fact that disclosures of references can be combined does not make the combination "obvious" unless the art also contains something to suggest the desirability of the combination. In re Rinehart, 189 USPQ 143 (CCPA 1975); In re Regel, 188 USPQ 136 (CCPA 1975); In re Avery, 186 USPQ 161 (CCPA 1975); In re Imperato, 179 USPQ 730 (CCPA 1973); and In re Andre, 144 USPQ 497 (CCPA 1965).

In other words, to properly combine two references to reach the conclusion that the subject matter of a patent would have been "obvious," case law now clearly requires that there must have been some teaching, suggestion or inference in either one of the two references, or both, or knowledge generally available to one of ordinary skill in the relevant art which would have led one skilled in the art to combine the relevant teachings of the two references. See, e.g., ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984); W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303, 311, (Fed. Cir. 1983); and In re Sernaker, 217 USPQ 1, 5 (Fed. Cir. 1983).

The Federal Circuit has recently again strongly reaffirmed this cardinal principle of law. In In re Dembiczak, 50 USPQ 2d 1614, 1717-1618 (Fed. Cir. 1999), the Court stated:

All the obviousness rejections affirmed by the Board resulted from a combination of prior art references, e.g., the conventional trash or yard bags, and the Holiday and Shapiro publications teaching the construction of decorated paper bags. *See Dembiczak*, slip op. at 6-7. To justify this combination, the Board simply stated that "the Holiday and Shapiro references would have suggested the application of . . . facial indicia to the prior art plastic trash bags." *Id.* at 18-19. However, rather than pointing to specific information in Holiday or Shapiro that suggest the combination with the conventional bags, the Board instead described in detail the similarities between the Holiday and Shapiro references and the claimed invention, noting that one reference or the other -- in combination with each other and the conventional trash bags -- described all of the limitations of the pending claims. *See id.* at 18-28. Nowhere does the Board particularly identify any suggestion, teaching, or motivation to combine the children's art references (Holiday and Shapiro) with the conventional trash or lawn bag references, nor does the Board make specific -- or even inferential -- findings concerning the identification of the relevant art, the level of ordinary skill in the art, the nature of the problem to be solved, or any other factual findings that might serve to support a proper obviousness analysis. *See, e.g., Pro-Mold & Tool*, 75 F. 3d at 1573, 37 USPQ2d at 1630.

To the contrary, the obviousness analysis in the Board's decision is limited to a discussion of the ways that the multiple prior art references can be combined to read on the claimed invention. For example, the Board finds that the Holiday bag reference depicts a "premanufactured orange" bag material, *see Dembiczak*, slip op. at 21, finds that Shapiro teaches the use of paper bags in various sizes, including "large", *see id.* at 22-23, and concludes that the substitution of orange plastic for the crepe paper of Holiday and the paper bags of Shapiro would be an obvious design choice, *see id.* at 24. Yet this reference-by-reference, limitation-by-limitation analysis fails to demonstrate how the Holiday and Shapiro references teach or suggest their combination with the conventional trash or lawn bags to yield the claimed invention. *See Rouffet*, 149 F.3d at 1357, 47 USPQ2d at 1459 (noting Board's failue to explain, when

analyzing the prior art, "what specific understanding or technical principle . . . would have suggested the combination"). Because we do not discern any finding by the Board that there was a suggestion, teaching, or motivation to combine the prior art references cited against the pending claims, the Board's conclusion of obviousness, as a matter of law, cannot stand. See *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232; *Rouffet*, 149 F.3d at 1359, 47 USPQ2d at 1459; *Fritch*, 972 F.2d at 1265, 23 USPQ2d at 1783; *Fine*, 837 F.2d at 1075, 5 USPQ2d at 1600; *Ashland Oil*, 776 F.2d at 297, 227 USPQ at 667.

(emphasis added)

It is submitted that the Examiner has simply used the claims of this application as a blueprint and abstracted individual teachings from the different pieces of prior art to create the combination upon which he rejected the claims of this application. There is no teaching, suggestion or motivation, in any of the references, for their combination. Moreover, the combination does not even produce applicants' invention, as is specifically set out in the claims. This was error as a matter of law. In Re Dembiczak, 50 USPQ 2d at 1618 (Fed. Cir. 1999); W.L. Gore, 220 USPQ at 312 (Fed. Cir. 1983).

The Federal Circuit recently spoke again on this issue. In In Re Sang-Su Lee, 61 USPQ2d 1430 (Fed. Cir. 2002), the Court first set out the legal standard:

As applied to the determination of patentability vel non when the issue is obviousness, 'it is fundamental that rejections under 35 U.S.C. §103 must be based on evidence comprehended by the language of that section.'

In re Grasselli, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983). The essential factual evidence on the issue of obviousness is set forth in Graham v. John Deere

Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966) and extensive ensuing precedent. The patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. See, e.g., McGinley v. Franklin Sports, Inc., 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001) ('the central question is whether there is reason to combine [the] references,' a question of fact drawing on the Graham factors).

'The factual inquiry whether to combine references must be thorough and searching.' Id. It must be based on objective evidence of record. This precedent has been reinforced in myriad decisions, and cannot be dispensed with. See, e.g., Brown & Williamson Tobacco Corp. v. Philip Morris Inc., 229 F.3d 1120, 1124-25, 56 USPQ2d 1456, 1459 (Fed. Cir. 2000) ('a showing of a suggestion, teaching, or motivation to combine the prior art references is an 'essential component of an obviousness holding'') (quoting C.R. Bard, Inc., v. M3 Systems, Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998)); In re Dembiczak, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ('Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references.'); In re Dance, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (there must be some motivation, suggestion, or teaching of the desirability of making the specific combination that was made by the applicant); In re Fine, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988) ('teachings of references can be combined only if there is some suggestion or incentive to do so.') (emphasis in original) (quoting ACS Hosp. Sys., Inc. v. Montefiore Hosp., 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)).

The need for specificity pervades this authority. See, e.g., In re Kotzab, 217 F.3d 1265, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000) ('particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed'); In re Rouffet, 149 F.3d 1350, 1259, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998) ('even when the level of skill in the art is high, the Board must identify specifically the principle, known to one of ordinary skill, that suggests the claimed combination. In other words, the Board must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.); In re Fritch, 972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992) (the examiner can satisfy the burden of showing obviousness of the combination 'only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references').

The Court then went on to identify the reversible error made by the Examiner and the Board in their obviousness analyses:

With respect to Lee's application, neither the examiner nor the Board adequately supported the selection and combination of the Nortrup and Thunderchopper references to render obvious that which Lee described. The examiner's conclusory statements that 'the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software' and that 'another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial' do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper in determining whether a person of ordinary skill would have been led to this combination

of references, simply to ‘[use] that which the inventor taught against its teacher.’ W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency’s conclusion.

In its decision on Lee’s patent application, the Board rejected the need for ‘any specific hint or suggestion in a particular reference’ to support the combination of the Nortrup and Thunderchopper references. Omission of a relevant factor required by precedent is both legal error and arbitrary agency action. (citations omitted)

The foundation of the principle of judicial deference to the rulings of the agency tribunals is that the tribunal has specialized knowledge and expertise, such that when reasoned findings are made, a reviewing court may confidently defer to the agency’s application of its knowledge in its area of expertise. Reasoned findings are critical to the performance of agency functions and judicial reliance on agency competence. See Baltimore and Ohio R.R. Co. v. Aberdeen & Rockfish R.R. Co., 393 U.S. 87, 91-92 (1968) (absent reasoned findings based on substantial evidence effective review would become lost ‘in the haze of so-called expertise’). The ‘common knowledge and common sense’ on which the Board relied in rejecting Lee’s application are not the specialized knowledge and expertise contemplated by the Administrative Procedure Act. Conclusory statements such as those here provided do not fulfill the agency’s obligation. This court explained in Zurko, 258 F.3d at 1385, 59 USPQ2d at 1697, that ‘deficiencies of the cited references cannot be remedied by the Board’s general conclusions about what is ‘basic knowledge’ or ‘common sense.’’ The Board’s findings must extend to all material facts and must be documented on the record, lest the ‘haze of so-called expertise’ acquire insulation from

accountability. ‘Common knowledge and common sense,’ even if assumed to derive from the agency’s expertise, do not substitute for authority when the law requires authority. See Allentown Mack, 522 U.S. at 376 (“Because reasoned decisionmaking demands it, and because the systemic consequences of any other approach are unacceptable, the Board must be required to apply in fact the clearly understood legal standards that it enunciates in principle . . .”)

The determination of patentability on the ground of unobviousness is ultimately one of judgment. In furtherance of the judgmental process, the patent examination procedure serves both to find, and to place on the official record, that which has been considered with respect to patentability. The patent examiner and the Board are deemed to have experience in the field of the invention; however, this experience, insofar as applied to the determination of patentability, must be applied from the viewpoint of ‘the person having ordinary skill in the art to which said subject matter pertains,’ the words of section 103. In finding the relevant facts, in assessing the significance of the prior art, and in making the ultimate determination of the issue of obviousness, the examiner and the Board are presumed to act from this viewpoint. Thus when they rely on what they assert to be general knowledge to negate patentability, that knowledge must be articulated and placed on the record. The failure to do so is not consistent with either effective administrative procedure or effective judicial review. The board cannot rely on conclusory statements when dealing with particular combinations of prior art and specific claims, but must set forth the rationale on which it relies.

(emphasis added)

The same holds true here. The Examiner has not adequately supported the selection and combination of the references. The Examiner has simply made the

conclusory statement in the Official Action that "Edwards discloses a casket lid that is molded using cellulosic material (wood pulp, rice straw, paper pulp) in an appropriately shaped mold. Elder shows a casket lid having a crown, pie, rim and header. It would have been obvious to one of ordinary skill in the art to use the method of Edwards to form a casket with a pie, crown, rim and header because this is a conventional shape for caskets as evidenced by Elder." This simply does not adequately address the issue of motivation to combine. "Can be combined" is not the same as "is obvious to combine." This obviousness question is not resolved by the Examiner's subjective belief and unknown authority. Where in the record, Appellants rightfully ask, is the evidence of motivation to combine these references? There simply is none. Omission thereof is both legal error and arbitrary agency action. For this additional reason the §103 obviousness rejections of claims 21 and 35 and their dependent claims, are improper as a matter of law and should be reversed.

The Examiner's obviousness rejection of the claims can, then, only be based on his own speculation. However, it is well settled that the Examiner is prohibited from substituting his own speculation and unfounded assumptions for the factual knowledge of a person skilled in the art. As was stated more than thirty years ago by the CCPA:

The Supreme Court in Graham [Graham v. John Deere Co., 383 U.S. 1] and Adams [U.S. v. Adams, 383 U.S. 39], supra, foreclosed the use of substitutes for facts in determining obviousness under section 103. The legal conclusion of obviousness must be supported by facts.

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

In Re Warner and Warner, 154 USPQ 173, 177-178 (CCPA 1967) (emphasis in original).

The CCPA's statement of the law is as valid today as it was then. For example, the Board itself has since stated:

As stated in In Re Warner, 379 F.2d 1011, 154 USPQ 173 (CCPA), the legal conclusion of obviousness must be supported by facts. Where the legal conclusion is not supported by facts it cannot stand.

Ex parte Saceman, 27 USPQ 2d 1472 (Bd. Pat. App. and Int. 1993) (emphasis added).

It is submitted that there simply is no factual basis for the obviousness rejections in this application; the Examiner merely speculates -- such is not the proper basis for an obviousness rejection.

Therefore, it is submitted that independent claims 21 and 35 are in fact allowable. It is also submitted that the various dependent claims which depend either directly or indirectly on those independent claims are allowable for at least the same reasons, as well as others.

In view of the above, it is submitted that claims 21-23 and 35 are allowable. Re-examination of the application is respectfully requested, and an early Notice of Allowance is earnestly solicited.

Respectfully submitted,

WOOD, HERRON & EVANS, L.L.P.

By:

Wayne E. Jacobs
Reg. No. 35,553

2700 Carew Tower
Cincinnati, OH 45202
(513) 241-2324